

offer conflicting instructions on how to handle the ball. Even Fig. 6 shows that at least part of the palm touches the ball. Because Fig. 6 shows at least part of the palm touching the ball, it cannot be the claimed “indicia indicating that the person’s palm should not touch the ball.” (emphasis added).

Said another way, Figs. 5 and 6 show a release hand including a representation of the hand’s palm and fingers. Fig. 6 shows an incomplete representation of the palm, but a representation nonetheless. However, the representation of the palm does not have “indicia indicating that the person’s palm should not touch the ball.” And the patent does not support any argument that such indicia is implied.

The Examiner’s argument in ¶ 6 of the Action is incomplete because there is apparently a missing case citation. Assuming the Examiner intended to refer to cases like *In re Gulack*, the Claim 1 combination is patentable because it is novel and because there is a definite relationship between the indicia and the claimed substrate – a sports ball. The patent teaches in ¶¶ 0005 and 0020 that by adopting the teachings of the indicia – avoiding palm contact, a user can control and pass the ball in the proper way. This is a new and non-obvious teaching over the prior art as shown in Williams, for example, which never says that avoiding palm contact with the ball is beneficial; and Williams – taken as a whole – shows that the palm should touch the ball.

Patentability of Claim 1 is actually supported by the holding in the *Gulack* case. In *Gulack*, the Federal Circuit reversed the examiner’s rejection, finding that there was a functional relationship between the printed matter and the substrate:

We reject the board’s conclusion that there is no functional relationship between the printed matter and the substrate of

the appealed claims. Such a relationship does exist and it is different from the relationship exhibited by the corresponding elements of the Wittcoff reference. We find no suggestion in the cited reference of appellant's particular sequence of digits Q or of the derivation of that sequence.

*In re Gulack*, 217 U.S.P.Q. at 405. Accordingly, for the reasons stated here and in Applicant's earlier paper, claims 1, 8, and 9 should be allowed, which allowance is respectfully solicited.

### **The §103 Rejections**

Applicant stands by its earlier position as to these rejections. The Examiner did not make a *prima facie* case as required by the M.P.E.P., and the law and regulations stated therein. The prior art simply fails to teach or suggest the claimed combinations including a ball (the substrate) and novel indicia disposed on the ball for using the ball. The prior art shows balls and indicia on the balls. But the prior art indicia is different from the claimed indicia in the present case.

The Examiner contends that the differences in the claimed indicia are not entitled to patentable weight unless there is a functional relationship between the printed matter and the substrate of the claims, and the Examiner relies on the *In re Gulack* case for this proposition. But here, just like in *Gulack*, there is a "functional relationship between the printed matter and the substrate of the ... claims. Such a relationship does exist and it is different from the relationship exhibited by the corresponding elements of the [prior art] ... reference." *In re Gulack*, 217 U.S.P.Q. at 405. The present application states in ¶¶ 0005, 0016, and 0020, among other places, that the hand placement indicia permits better control and release of the ball – i.e. the substrate. This is a new and non-obvious

relationship between indicia and ball – new over the prior art like Williams, Poegel, and Page. These references, to the extent that they teach hand placement at all, fail to include indicia teaching the correct hand placement information. For example, releasing a basketball with the index finger being the last finger to contact the ball, as taught by Williams (Col. 2, lines 33-35), is simply wrong.

In this regard, Claim 10 is not obvious because the prior art does not have indicia on the ball showing the correct hand placement elements, including finger indicia indicating that the person should release the ball with the three middle fingers. No prior art has such indicia.

Claim 12 is not obvious in view of Williams and Poegel, because Claim 12 recites indicia indicating that the middle finger is the last of the fingers to contact the ball, not the index finger.

Claim 4 is likewise not obvious in view of the prior art because no prior art teaches indicia indicating pad control.

Claims 5 and 6 also recite subject matter that is nowhere taught or suggested in the prior art.

Accordingly, claims 2-7 and 10-13 are also in allowable form, which allowance is respectfully solicited.

For the foregoing reasons it is believed that this Response places the claims now appearing in this case in condition for allowance, and an early notice to such effect is respectfully solicited.

In the event that the Examiner does not agree that the claims are now in condition

Amdt. dated February 9, 2005

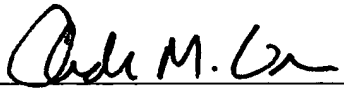
Reply to Office action of January 10, 2005

for allowance, he is courteously invited to contact the undersigned at the number given below in order to discuss any changes which the Examiner believes would lead to an allowance of the claims.

It is not believed that any new fees are necessitated by the entry of this response. However in the event that any new fees or charges are required, authorization is hereby given to charge such fees to applicant's Deposit Account No 50-0852. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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